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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,709	12/11/2003	Roy Pinney		2339

Roy Pinney
515 SW 14th. Court
Fort Lauderdale, FL 33315

EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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11/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/734,709	PINNEY, ROY	
	Examiner	Art Unit	
	Hoang-Vu A. Nguyen-Ba	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed December 11, 2003.
2. The claims have been examined.

Priority

3. The priority date considered for this application is December 11, 2003.

Oath/Declaration

4. The Office acknowledges receipt of a properly signed oath/declaration filed

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the citizenship (e.g. United States) of the inventor. Instead, it does identify the city and either state or foreign country of residence of the inventor.

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Drawings

5. The drawings are objected to because of the following informalities:

a. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

b. FIGs. 1-7:

the dark parts of the drawings are too dark to show details in these parts; and when they are printed with lighter settings, some parts (e.g., edges of the devices such as the TV set) are missing;

the components shown in the FIGs. 1-7 appear to be substantially the same; some of the legends are different; when the legends in FIGs 2-7 contain more details, these details are not pictorially shown so as to distinguish over the previous drawings. For example, see FIG. 2 where the legend of item 7 shows more details such as "with built-in TV out video card with scan converter and built-in wireless transmitter"; these details, however, are not shown on the Consumer's Computer and thus the consumer's computer in FIG. 2 is the same as the counterpart in FIG. 1;

the built-in TV out video card, scan converter and built-in wireless transmitter mentioned in the specification should each have a reference number that should be also shown in the corresponding drawing;

the specification mentions "[t]his version of the inventor's

[s]ystem utilizes a TV-out video card with scan converter and wireless transmitter built into the computer's CPU case." It is not clearly understood whether the features so described in the subject matter of the invention or not because the specification specifically mentions "this version of inventor's invention." If these features are claimed to be the invention of Applicant, they should be illustrated in FIG. 2 and thus FIG. 1 should be labeled as "Prior Art" because only that which is old is illustrated. See MPEP § 608.02(g).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

7. The specification is objected to because of the following minor informalities:

a. The title of the invention is not descriptive. It is not understood how a "portal web site" could send signals to a consumer's home stereo system and/or television set? One of the definitions of the term "portal" found by using "define: portal" function of Google is:

A site designed to act as an entryway to the World Wide Web.
www.microsoft.com/technet/prodtechnol/Visio/visio2002/plan/glossary.mspx

As defined the portal web site is merely a document created with HTML that is part of a group of hypertext documents or resources available on the World Wide Web. As such, it is not understood how the HTML-based document could send electromagnetic signals to a consumer's home stereo and/or television.

A new title is required that is clearly indicative of the invention to which the claims are directed.

b. The Abstract is objected to because of the use of such phrases as "The INVENTION'S SYSTEM hereafter referred to as ("my invention") is an invention of Roy Pinney. My invention..."

It is unclear as to whether Applicant's invention is a machine, apparatus, article and its method of making, or a process.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

- c. The specification lacks a Brief description of the drawings.
- d. The use of trademarks, such as Bluetooth (p. 7), Media Player, Real Player has been noted in this application (p. 2, in paragraphs 2f and 2g of FIG. 9 description). Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in a manner which might adversely affect their validity as trademarks.

To expedite correction on this matter, the examiner suggests the following guidelines for Applicant to follow in amending the specification:

- i. capitalize each letter of a trademark or accompany the trademark with an appropriate designation symbol, e.g., TM or ®, as appropriate;
 - ii. use each trademark as an adjective modifying a description noun. For example, it would be appropriate to recite “the JAVA platform” or “the JAVA programming language.” Note that in these examples, “platform” and “programming language” provide accompanying generic terminology, describing the context in which the trademark is used. By itself, the trademark JAVA specifies only the source of the so-labeled products, namely SUN Microsystems, Inc.
- e. The content of the specification should be paged continuously from page 1 to the end. Only the drawings, claims and abstract need be on a separate page (see paragraphs (j) and (k) of the following guideline:

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.

- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.
- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and

gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB)

of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

- (l) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.
- f. Drawings should be deleted from the specification.
- g. the acronym SECAM stands for “Systeme Electronique Pour Couleur Avec Memoire); a “E” should be inserted before “Lectronique”.
- h. The term “vid o” at page 2 of the description section of FIG. 8 should be – video –
- i. The term “consum r’s” at page 1 of the description section of FIG. 10 should be – consumer’s --.

Claim Objection

8. The claim is objected to because of the claim is not written according to the following guideline:

(j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

It is unclear what subject matter invention which Applicant regards as his invention.

Claim Rejections – 35 USC §112

9. The following is a quotation of the second paragraph of the 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. The claim is rejected under 35 U.S.C. §112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Trademark in claim:

Claim recite the limitations “Media Player” and “Real Player” (item G. and H. at page 11 of the claim) are trademarks.

The presence of a trademark or trade name in a claim is not per se improper under 35 U.S.C. § 112, second paragraph. However, it is important to recognize that a trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name.

If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. § 112, second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

If the trademark or trade name is used in a claim as a limitation to identify or describe any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

- b. The claim is rejected under 35 U.S.C. § 112, second paragraph because of the use of exemplary language such as “For example,” “etc.” (see pp. 1, 2, 5, 6, 8) because the intended scope of the claim is not clear.
- c. The claim is rejected under 35 U.S.C. § 112, second paragraph as being indefinite because of the use of Internet addresses (p. 8). These Internet addresses change often and thus become a variable. See MPEP 2173(b) Relative Terminology, Reference to an Object that is Variable may render the
- d. The claim recites the limitation “may include” in line “recordings may include “midnight rain...” The recitation of the limitation is in permissive language. The broadest reasonable interpretation of this limitation is that the “midnight rain” or “seashore” is optional feature. The use of the verb “may” renders the claim indefinite. Accordingly, any arguments that this feature provides patentable distinction over the prior art will be unpersuasive. It is noted that the same objection is applied to other locations in the claim where

the verb “may” is used.

e. The claim recites limitations in multiple sentences without indentation.

see paragraph (j) of above guidelines.

f. The claim contains note (see p. 3, “Note – all cables contain...”

g. The claim recites the limitation “optionally” in line “..., and optionally the path to a file or resource...” at p. 8 of the claim. The recitation of the limitation is in optional language. The broadest reasonable interpretation of this limitation is that the “the path to a file or resource residing on that server (trade)” is optional feature. The use of the adverb “optionally” renders the claim indefinite. Accordingly, any arguments that this feature provides patentable distinction over the prior art will be unpersuasive. It is noted that the same objection is applied to other locations in the claim where the adverb “optionally” is used.

h. The claim is indefinite because it is unclear as to which subject matter which Applicant regards as the invention. The claim recites the following commonly known items:

a service (e.g., subscription fee, free advertisements, combination of both) hardware (e.g., monitor, sound card, TV video card, scan converter, keyboard, mouse, modem), Internet service provider, wireless transmitter and receiver, Y audio/video adapter cable, Web browser (i.e., Internet application

for consumer's use at p. 4), search facilities similar to Google, Yahoo, Amazon (i.e., search page, advanced search page, etc.), selection of default audio and video players such as Real® Player, etc.

The scope of the invention is not clearly defined in order to ascertain the definite boundaries on the patent protection of the subject matter of the invention sought and for interference purposes.

11. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. § 112, second paragraph. In *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. § 112, second paragraph.

In the instant claim, it is unclear whether a product (e.g., marketing program, application software, hardware, Y audio/video adapter cable, etc.) or a process (e.g., search for entertainment items, login process, adding/removing, modifying information sources, ad banners, audio/video streaming, configuring ad pages, tracking and recording banner ad's statistics) is claimed.

Correction is required.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Pursuant to Applicant's claim, a single claim which claims both an apparatus and the method steps of using the apparatus should also be rejected under 35 U.S.C. §

101, *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter 1990), based on the theory that the claim is directed to neither a “process” nor a “machine,” but rather overlaps two different statutory classes of invention set forth in 35 U.S.C. § 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* At 1551.

14. The instant claim is rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter.

Applicant’s claim recites “My application (software).” Such claimed matter, which is functional descriptive material per se, is not statutory because it is not a physical “thing” nor a statutory process as there are no “acts” being performed. Such claimed computer program does not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer’s program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable storage medium needed to realize the computer’s functionality. In contrast, a claimed computer-readable storage medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program’s functionality to be realized, and is thus mandatory. *Warmerdam*, 33 F.2d at 1361, 31 USPQ 2d at 1760. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 178). See MPEP §2106 (IV)(B)(1)(a).

Although hardware is also claimed in the same claim, it should be noted that a single claim that claims both nonstatutory (software) and statutory subject matters is nonstatutory.

Conclusion

15. The specification, drawings and claim are all deficient and are such that a thorough examination including a reasonable search and art rejection could not be performed by the examiner.

Appropriate corrections are required.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2600 Group receptionist (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



ANTONY NGUYEN-BA
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100

Application/Control Number:
10/734,709
Art Unit: 2623

Page 18

November 21, 2007